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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,995	06/28/2000	Cory O. Nykoluk	16513-2424	6151

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EXAMINER

MAI, TRI M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/604,995

Applicant(s)

NYKOLUK, CORY O. GID

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claims 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Original disclosure does not support the backing sheet being twistable relative to each other via the flexible fabric. This is a new matter rejection.
2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The handle does not appear connected to the base **immediate** the at least two wheels. It is unclear what is meant by "immediate".

### *Claim Rejections - 35 USC § 102/103*

3. Claims 2-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Mao (6,279,706). Mao teaches a piece of baggage having a rigid base 23, two wheels 26, a rigid towing member 30, ball-and-socket joint for connecting the arcuate handle to conform to the user as shown in Fig. 8., and a backing sheet between portions 30 and 20 in Fig. 6.
4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadow (6298964) in view of Bergman (5109961). Sadow teaches a pack having a rigid base at portion 23, a rigid towing member 44 connected to the base by a joint, i.e. a flexible fabric joint,

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allowing the pivoting of the handle as shown in Fig. 9., a resilient backing sheet 14 for pivotal movement together with the handle as shown in Fig. 9.

To the degree it is argued that Sadow does not teach a rigid base, it would have been obvious to one of ordinary skill in the art to provide a rigid base in Sadow as taught by Bergman to provide added support to the case.

Regarding claim 9, note portions 91 in Fig. 11, and 104 in Fig. 13 are the channels as claimed.

Regarding claim 8, note the single pole member in Fig. 1.

5. Claims 7, and 8 are rejected under 35 U.S.C. 102(a) as being anticipated by Lin (6179101). Lin teaches a rigid base at portion 20, a towing member connected to the base by a joint, and a flexible backing sheet 16 as shown in 13.

6. Claims 4, 5, 6, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Miyoshi (5908093). Lin meets all claimed limitations except for the curved handle. Miyoshi teaches that it is known in the art to provide a curved handle. It would have been obvious to one of ordinary skill in the art to provide a curve handle in Lin as taught by Miyoshi to tow the luggage easily.

7. Claim 10 is rejected under 35 U.S.C. 102(a) as being anticipated by Miyoshi, or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Miyoshi in view of either Carrigan, Jr. (5002304) or Hildebrandt (EPO719511). Miyoshi teaches a handle extending upwardly and forwardly from the pack. Note that the direction of handle 53 is forward, i.e., the handle is attached in the back and extending in the forward direction.

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To the degree it is argued Miyoshi does not teach the curved handle as claimed. Either Carrigan, Jr. or Hildebrandt teaches that it is known in the art to provide a handle that is facing upward and forwardly. It would have been obvious to one of ordinary skill in the art to change the direction of the handle so that it extend forwardly from the luggage to tow the luggage in a different direction.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi in view of Carrigan, Jr., and further in view of Sadow (6298964). Sadow teaches that it is known in the art to use a single pole instead of a two arms handle. It would have been obvious to one of ordinary skill in the art to use a single pole in the Miyoshi combination as taught by Sadow to reduce weight.

9. Claims 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelb (WO9638066) in view of JP' 929. Gelb teaches a backpack having a rigid base, and two shoulder straps. Gelb meets all claimed limitations except for the backing sheet. JP' 929 teaches that it is known in the art to provide a backing sheet 22. It would have been obvious to one of ordinary skill in the art to provide a back sheet in Gelb as taught by JP'929 to enable one to transport the bag comfortably.

The backing sheet and the base are twistable as claimed.

10. Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by JP'285329. JP329 teaches a backpack having a first side 11 having two shoulder straps backing sheet at portion W is twistable with respect to the rigid bottom as claimed.

*Conclusion*

11. As set forth in the previous Office Action, the Declaration filed on 09/23/02 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mao reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Mao reference to either a constructive reduction to practice or an actual reduction to practice. In fact, there is no evidence from a date prior to the date of reduction to practice prior to the filing date of the Mao reference.

Furthermore, according to the Declaration of Mr. Nykoluk, the showing of the pictures is not persuasive. The luggage in the pictures was constructed from designs on a date prior to June 13. There is no actual evidence of the any design on a date prior to June 13, 2000.

Furthermore, the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Mao reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The evidence fails to show the necessary elements as set forth by the claims and the specification, i.e. elements 38, 48, 74, etc.

With respect to the rejection over the Miyoshi reference, the amended claims do not read over the Miyoshi reference. As set forth above, Miyoshi teaches a towing handle that extends along an arcuate path curved away from the pack, upwardly and forwardly, i.e., away from the top wall, upwardly and toward the forward side (the front side) of the pack.


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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Tri M. Mai   
Primary Examiner  
Art Unit 3727

June 25, 2003